

Remarks

Attention is called to the inventor's declaration under 37 CFR 1.132, which is a true copy of the declaration first submitted under application 09/416,017 the original parent of the pending application.

1. The declaration shows that the water content of the shell is a critical parameter in the flavored fish oil capsules because it determines the hardness of the shell and the permeability to air. The more exposure of the fish oil to air, the greater is its deterioration. It is submitted that Coapman (US 5,141,961) operates intentionally outside of the range of the instant application (in the range of 6% to 10 %). Coapman requires 15% to 50% water in the gelatin shells (preferably 25% to 40% and most preferably 30% to 40%). The reason is that Coapman desires a capsule which dissolves quickly in gastrointestinal fluids. Gorenbein (US 5,955,102) does not teach on water content. Coapman's quick dissolving capsule therefore teaches away from the instant invention.
2. The declaration shows that the amount of flavoring is an important variable in a successful flavored gelatin capsule, preferably in the range 0.25% to 1.5%. Surprisingly too much flavoring can yield a bitter capsule. Coapman merely lists "flavorings" as one optional ingredient along with other aesthetically pleasing components. Gorenbein doesn't teach on flavoring at all, but recognizes that gelatin capsules of some type are a preferred way of dispensing fish oil supplement. Coapman and Gorenbein combined are not a complete disclosure of adding flavoring to fish oil capsules but are merely an idea, an invitation to try, which the Board has concluded is not sufficient to render the subject matter obvious. (*Ex parte Obukowicz*, 27 USPQ2d 1063, 1065 (B.P.A.I. 1992); [The] specific statement regarding combating mosquitoes using genetically engineered "natural pond microflora" is relied on by the examiner for the "suggestion" required by the aforementioned case law. However, the specific statement by Dean is not a suggestion to insert the

gene into the chromosome of bacteria and apply that bacteria to the plant environment in order to protect the plant. At best, the Dean statement is but an invitation to scientists to explore a new technology that seems a promising field of experimentation. The Dean statement is of the type that gives only general guidance and is not at all specific as to the particular form of the claimed invention and how to achieve it. Such a suggestion may make an approach "obvious to try" but it does not make the invention obvious.)

3. Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. The prior art of record fails to provide any such suggestion or incentive. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 221 USPQ 929, 932, 933 (Fed. Cir. 1984). In the present case, Coapman teaches a process for producing rapidly dissolving capsules for difficultly soluble pharmaceutical actives, by dissolving the pharmaceutical in a mixture of polyethylene glycol and polyvinylpyrrolidone while Gorenbeim teaches use of soft gelatin capsules for dispensing fish oils (no mention of solution). There is no suggestion of combining the references. Whose only commonality is the use of some form of soft gelatin capsule. It should be noted that the combination of Coapman and Gorenbein does not yield a fish oil capsule at all, but rather a capsule with fish oil dissolved in solvents. Coapman and Gorenbein are completely different approaches.
3. A "useful general rule," is that references that teach away cannot serve to create a *prima facie* case of obviousness. *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130 (Fed. Cir. 1994). Coapman teaches away from the composition in the instant application with respect to water content.

4. Claim 1, 6, and 7 are amended , without prejudice, to remove the passage referring to the quantity flavoring being such as to improve the taste (, however it

is respectfully pointed out that the specification does exactly specify the amount of flavoring required to improve the taste of the capsules, and reconsideration is requested.

4. Claims 10-13 are cancelled.
5. A terminal disclaimer is submitted to overcome the double patenting rejection.
6. Applicant believes that the application is now in condition for allowance and requests notice of allowance for claims 1 through 9.

Please contact the undersigned attorney for discussion of this application.

Respectfully submitted,



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